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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,524	01/09/2004	Shunpei Yamazaki	07977-218003 / US3531/361	7877
26171	7590	05/24/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			MONDT, JOHANNES P	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/753,524

Applicant(s)

YAMAZAKI ET AL.

Examiner

Johannes P. Mondt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-23, 25 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23, 25 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/20/05, 10/12/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment filed 3/10/06 forms the basis of this office action. In said Amendment applicant substantially amended claims 21, 22, 23 and 25 through substantial amendment of independent claim 21, and added new claim 42. Comments on Remarks submitted with said Amendment are included below under "Response to Arguments".

### ***Information Disclosure Statement***

The examiner has considered all items listed in the Information Disclosure Statement filed December 20, 2005; a signed copy of Form PTO-1449 is herewith enclosed.

The examiner has considered all items listed in the Information Disclosure Statement filed October 12, 2005 except item AR. Item AR has not been submitted. The information disclosure statement filed 10/12/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Applicant is invited to submit a legible copy of item AR. It is realized that item AR is a family member of item AN. However, in the absence of a copy of item AR said item AR cannot be considered in its own right. Applicant is invited to submit a legible copy of item AR.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 21 and 42** are rejected under 35 U.S.C. 102(b) as being anticipated by Iwasaki (JP 08-288515 A). For translation, family member Iwasaki (USPAT 5,759,879) is available and is cited below.

Iwasaki teaches (whole document, especially title, abstract, "Field of the Invention", column 1, lines 7-20, and Examples 1-2, columns 7-12; Figures 2-3) a semiconductor film 22 (column 10, lines 45-48) over a substrate 16 (loc.cit.) and comprising a source region and drain region (both 26N; see column 10, line 50) and a channel formation region 26i (column 10, lines 49-50) provided between said source and drain regions; and a gate electrode 25 (column 10, line 55) provided adjacent to said channel formation region with a gate insulating film 24 (column 10, line 54) therebetween; wherein lattices are continuously connected to each other at a grain boundary 23 (Figure 3F and column 12, lines 17-18) of said semiconductor film, inherently so, because a grain boundary is a boundary, i.e., a line, point or plane that indicates or fixes a limit or extent, between two grains, i.e., crystal grains; said crystal grains inherently having spatial extent, as otherwise their defining property, i.e., spatial periodicity, could not possibly exist; the lines denoting the grain boundaries in Figure 3F thus denote the limits on either side of the crystal grains connected by their common grain boundaries, implying continuity across said grain boundaries; hence the lattices of said grains, extending by definition of the grains over their entire spatial domain, are continuously connected to each other at the grain boundaries of said semiconductor film. On claim

42, the direction of movements of any of the (charge) carriers has inherently two components, a random component and a component in response to the local (mainly electric) field. While the direction of said random component by its very nature is not subject to control, the component in response to the local field is a result of the operation of the device, and hence is not a limitation of the device as such.

Therefore, the limitation on the direction of movement of a carrier in said channel formation region is a statement of intended use not serving to patently distinguish the claimed structure over that of the reference as long as the structure of the cited reference is capable of performing the intended use. See MPEP 2111-2115. See also MPEP 2114 that states:

“A claim that contains a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all of the structural limitations of the claim *Ex parte Masham*, 2 USPQd 1647.”.

“Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531.”

“Apparatus claims cover what a device is, not what a device does” *Hewlett-Packard versus Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.”

In the underlying case, direction of movement of at least one carrier, in particular during the ON state, in said channel formation region coincides with, i.e., is parallel to, the direction of extension of said grain boundary, i.e., the direction along which said grain boundary is extended (see, for instance Figures 2B and 3F (grain boundary

extended along 23, which has portions parallel to the channel between source and drain 26N (see Figure 3I, e.g.). Therefore, the device of the prior art is capable of performing the intended use.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claim 22*** is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki as applied to claim 21, in view of Erhart et al. (USPAT 5,572,211).

As detailed above, Iwasaki anticipates claim 21. Iwasaki does not necessarily teach the further limitation defined by claim 22, although Iwasaki does teach the inclusion of TFTs in active matrix LCD displays for computers (column 1, lines 7-20).

However, it would have been obvious to include said further limitation in view of Erhart et al, who teach the inclusion of *capacitors*, e.g., 56 and 58 (column 6, line 55 – column 6, line 15), in addition to thin film transistors e.g., 48 and 50 (column 6, lines 55-60) in an active matrix display (column 6, lines 16-55) in a *personal* computer (column 12, lines 45-49). *Motivation* to include the teaching by Erhart in the device by Iwasaki derives at least from the obvious advantage to apply the invention to improvements of existing technology, i.e., to active matrix LCD displays in personal computers wherein capacitors store charge corresponding to the desired shade for the pixel electrode to which said storage capacitor pertains (column 6, line 64 – column 7, line 4). N.B.: said

capacitors imply *auxiliary* capacitance because they are not part of the TFT, i.e., not part of the MOS capacitor that is part of the TFT.

3. **Claims 23 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki as applied to claim 21, in view of den Boer (USPAT 5,539,219).

As detailed above, Iwasaki anticipates claim 21. Iwasaki does not necessarily teach the further limitation as defined by claim 23, although Iwasaki does teach the computer (col. 1, l. 15-20) to further comprise an active matrix type liquid crystal display device (col. 1, l. 7-20). Iwasaki does not specifically recited pixel electrode and opposite electrode, with liquid crystal provided therebetween.

However, said limitation merely conforms to the conventional active matrix liquid crystal display technology, as witnessed for instance by den Boer et al., who teach an active matrix liquid crystal display device (column 1, lines 5-33) to comprise not only TFTs 21 (column 4, line 62 – column 5, line 8) but also pixel electrode 51 (column 5, lines 5-8 and column 8, lines 33-43), common electrode 59 (column 8, lines 37-39) opposite said pixel electrode and hence qualifying as “opposite” electrode (see Figure 5) with liquid crystal 57 between said pixel electrode and said opposite electrode.

*Motivation* to include said limitation as taught by den Boer in the invention by Iwasaki at least derives from the economy to apply the invention to already existing and hence easily marketable technology.

*With regard to claim 25*, Iwasaki does not specifically teach the further limitation on channel length as recited. However, it would have been obvious to include the limitation in view of den Boer, who teaches a channel length of about 2  $\mu\text{m}$  to 4  $\mu\text{m}$  (column 8,

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lines 8-19) so as to achieve a reduction in pixel flickering, image retention and an improvement in gray level uniformity (see abstract). Applicant is reminded *A prima facie* case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art or when the ranges of a claimed composition do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. In re Peterson, 65 USPQ2d 1379 (CA FC 2003). In the underlying case, the range in the prior art (about 2 to 4  $\mu\text{m}$ ) actually overlaps the range as claimed (less than or equal 2  $\mu\text{m}$ ) while motivation immediately derives from the teaching by den Boer that the shortened channel length enables reduction in pixel flickering and image retention and an improvement in grey level uniformity.

### ***Response to Arguments***

Applicant's arguments filed 3/10/06 have been fully considered but they are not persuasive. In particular, in claim 21 an entirely new limitation has been substituted for the previous one; claim 21 is anticipated by the prior art (see rejection under 35 USC 102(b) above). The new claim is being examined for the first time.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPM  
May 20, 2006



R. J. PALABRICA  
PRIMARY EXAMINER